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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,801	02/20/2004	Louis B. Rosenberg	IMMR-038/06US	5176
22903	7590	08/24/2004	EXAMINER	
COOLEY GODWARD LLP ATTN: PATENT GROUP 11951 FREEDOM DRIVE, SUITE 1700 ONE FREEDOM SQUARE- RESTON TOWN CENTER RESTON, VA 20190-5061			WACHSMAN, HAL D	
			ART UNIT	PAPER NUMBER
			2857	
DATE MAILED: 08/24/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/781,801	Applicant(s) ROSENBERG ET AL.	
	Examiner Hal D Wachsman	Art Unit 2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2-20-04</u> . | 6) <input type="checkbox"/> Other: _____ |

1. PALM records for this application shows a claim for foreign priority to a 1999 document from Italy. The Examiner believes this entry to be in error based upon other records in this application as well as the parent application(s) and wishes to confirm that with the Applicant. If this foreign priority claim is on the Applicant's filing receipt, then the Applicant should send a request for correction of filing receipt.

2. The Preliminary Amendment filed 2-20-04 is improper under 37 C.F.R. 1.121 because single brackets which have been used by the Applicant in the specification amendments cannot be used to show deleted subject matter. For the deletion of five or fewer consecutive characters, double brackets may be used. The other option to show deletion is by strikethrough. In addition, for the specification amendments that are presented in this Preliminary Amendment, single underlining and not double underlining should be used to show added text. In addition, the Abstract presented in this Preliminary Amendment is also improper because there are no markings to show the changes relative to the immediate prior version. If the Applicant intended this Abstract to be a new or replacement Abstract, then this new or replacement Abstract must be submitted on a separate sheet (37 C.F.R. 1.72) in clean text (i.e. no markings) accompanied by an instruction for the cancellation of the previous Abstract. In addition, the Examiner respectfully notes that the amended Abstract submitted appears to have a grammatical error "The turntable turntable..". The Supplemental Preliminary Amendment filed 6-17-04 is also improper under 37 C.F.R. 1.121 as it employs single brackets and double underlining that should be single underlining. Appropriate correction is required.

3. Page 17 of the specification refers to U.S. application serial no. 08/092,974 filed 7-16-93 but does not provide the current status of that application. Appropriate correction is required.

4. Page 36, the last page of the specification in the last line has "What is claimed is:". However, this is normally placed on the first page of the claims, above the first claim.

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 61-78 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4, 6-8, 5 and 9-18, respectively of prior U.S. Patent No. 6,697,748. This is a double patenting rejection.

7. The following references are cited as being art of general interest: Evans et al. (5,505,003) which disclose the use of a rotating turntable in an generative measuring system, Ishiguro et al. (4,831,547) which disclose that to automatize complicated tasks a robot and a rotary table have been used, Kunzmann et al. (4,819,339) which disclose


the measuring of rotary table deviations and Hemmerle et al. (5,329,457) which disclose three-dimensional rotary tool point compensation.

8. No claims are allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hal D Wachsman whose telephone number is 571-272-2225. The examiner can normally be reached on Monday to Friday 7:00 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on 571-272-2216. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Hal D Wachsman
Primary Examiner
Art Unit 2857

HW
August 21, 2004